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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES OTIS, MEHRGAN KHAVARI,
JEFFREY R. POLLARD, and MARK C. HUTH

Appeal 2009-007406
Application 10/713,298
Technology Center 3700

Before: LINDA E. HORNER, WILLIAM F. PATE III, and
KEN B. BARRETT, *Administrative Patent Judges*.

PATE III, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 9-16. App. Br. 2. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

The claims are directed to a micromachining laser. Claim 9, reproduced below, is illustrative of the claimed subject matter:

9. An apparatus comprising:

at least one laser source that supplies a laser beam to operate on a substrate at a laser interaction zone to form a feature in the substrate;

a first nozzle oriented to deliver liquid along a first liquid supply path to the feature, so that the liquid is delivered to the laser interaction zone; and,

at least a second different nozzle oriented to deliver liquid to the laser interaction zone along a second different liquid supply path, wherein the first nozzle and at least the second different nozzle are selectively activated based upon the location of the laser interaction zone in the substrate.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Terada	US 2004/0197433 A1	Oct. 7, 2004
Hibst	DE 41 38 468	Jun. 3, 1993
Scaggs ²	WO 03/028943	Apr. 10, 2003

REJECTIONS

Claims 9, 10, and 12-16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hibst. Ans. 3.

Claims 14-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hibst and Scaggs. Ans. 4.

Claims 9-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hibst and Terada. Ans. 4.

OPINION

Appellants contend that the Examiner erred in rejecting claim 9 as being anticipated by Hibst or, in the alternative, as being unpatentable over Hibst and Terada, by failing to evaluate and consider the functional limitations of the claim. App. Br. 6-7, 8-10. We agree.

[W]here the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty of the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

In re Swinehart, 439 F.2d 210, 213 (CCPA 1971). Nevertheless, before an applicant can be put to this burdensome task, the examiner must provide sufficient evidence or scientific reasoning to establish the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990) (citations omitted).

² The Examiner uses an English equivalent in the form of US 2003/0062126 A1 to Scaggs.

The Examiner contends that “the intended use of the apparatus for particular work pieces does not impart patentability to the claims” and “[t]he use of selective nozzle usage would have been obvious at the time applicant’s invention was made to a person having ordinary skill in the art because the different flows assist in effecting feature shaping.” Ans. 3-5. These statements do not provide sufficient evidence or technical reasoning to establish that Hibst’s device alone, or as modified by the teachings of Terada, would inherently be capable of performing the recited function; “wherein the first nozzle and at least the second different nozzle are selectively activated based upon the location of the laser interaction zone in the substrate.” The Examiner also notes that “selective activation of different first and second nozzle does not preclude simultaneous use of first and second nozzles at one flow rate.” Ans. 3. Even if we accept the Examiner’s proposed construction of “selectively activated,” the Examiner has not addressed the limitation requiring that activation be based upon the location of the laser. App. Br. 9. All words in a claim must be considered in judging the obviousness of the claimed subject matter. *See In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

Since the Examiner failed to properly construe and address the limitations of claim 9, we are constrained to reverse the rejections of claim 9 along with the rejections of dependent claims 10-16.

DECISION

For the above reasons, the Examiner’s rejections of claims 9-16 are reversed.

Appeal 2009-007406
Application 10/713,298

REVERSED

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